

## **REMARKS**

Applicant has carefully reviewed the Final Office Action of May 22, 2009, prior to preparing this response. Claims 19-22, 24-26, 28-35, 37 and 38 are pending and have been rejected. Favorable consideration of the following remarks is respectfully requested.

### **Claim Rejections under 35 U.S.C. §103**

Claims 19-22, 24, 26, 28-33, 35, 37 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lundquist, U.S. Patent No. 5,228,441. Applicant respectfully traverses this rejection.

Independent claim 19 recites in part, “the braid is disposed over the distal end of the tubular shaft such that a portion of the braid is located proximal of the distal end of the tubular shaft.” Independent claims 28 and 37 recite similar limitations. Lundquist does not teach or suggest a device wherein the braid is disposed over the distal end of the tubular shaft. In response to Applicant’s previous arguments, the Examiner asserts, “[t]he Applicant argues that it would not be obvious to rearrange the orientation of the overlapping torque tube and braided member. The Examiner disagrees. Not only is it well within the level of the ordinary skill in the art to overlap tubes in various ways, it is also obvious to vary the size of tubular members to arrive at the desired diameter.” Applicant respectfully disagrees with this assertion. The arrangement of the catheter of the instant application has particular advantages. For example, at page 4, lines 13-17 of the parent specification, the specification recites, “[t]his construction allows the distal shaft portion 150 to be flexible or bendable in a lateral direction to facilitate steering of the shaft 20, but has enough torsional strength to allow torque to be efficiently transmitted by the user from the handle to the distal shaft portion 150 without give in the shaft 150.” Applicant respectfully asserts Lundquist provides no suggestion or motivation for such a modification. The only motivation appears to be gleaned from Applicant’s own specification, which is improper. MPEP 2141 II (C) states, “The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention.”

Lundquist teaches a torque tube 31 and a braided tubular member 54. The braided tubular member 54 is disposed underneath and/or within the torque tube. As shown in Figure 3

of Lundquist, both elements have a uniform outer diameter and a uniform inner diameter, with the exception of some slots 41 in torque tube 31. Torque tubes, in particular, are known to have a generally uniform outer diameter. This is significant to the discussion in light of another feature of the device of Lundquist. The outermost diameter of the device is defined by shrink tubing 46, the final dimensions of which are determined by the outer diameter of torque tube 31. Therefore, if one inverts the torque tube 31 and the braided member 54, putting braided element 54 over torque tube 31, it appears the maximum outer diameter of the device would increase. The outer diameter of these sort of intravascular devices is critical as the outer diameter is the dimension which limits what lumens the device can fit into. Increasing the outer diameter without any countervailing advantage being introduced produces a device that is less satisfactory for its intended purpose. Insofar as it may not be able to fit where it otherwise could have fit without the design change, the proposed modification may indeed render the prior art device unsatisfactory for its intended purpose. MPEP 2143.01 V states, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

Therefore, for at least the reasons set forth above, Lundquist does not teach or suggest each and every element of independent claims 19, 28 or 37. Furthermore, there is no motivation, suggestion or other reason for one of ordinary skill in the art to modify Lundquist to arrive the device as claimed. Reconsideration and withdrawal of the rejection are respectfully requested. For similar reasons and others, Applicant submits that claims 20-22, 24, 26, 29-33, 35 and 38 are also in condition for allowance as they depend from one of claims 19, 28 and 37 and they add significant limitations to further distinguish them from the prior art.

Claims 25 and 34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lundquist, U.S. Patent No. 5,228,441, in view of Schwartz et al., U.S. Patent No. 5,437,288. Applicant respectfully traverses this rejection.

Claim 25 depends from claim 19 and claim 34 depends from claim 28. For at least the reasons stated above, Lundquist fails to teach each and every limitation of claims 19 and 28. The teachings of Schwartz et al. fail to remedy the shortcomings of Lundquist. Thus, even if one were to combine Lundquist and Schwartz et al., one would not arrive at the device as claimed.

Furthermore, there is no motivation, suggestion or other reason for one of ordinary skill in the art to modify Lundquist and/or Schwartz et al. to achieve the device as claimed.

Therefore, because claims 19 and 28 are believed to be in condition for allowance, Applicant submits that claims 25 and 34, which depend from claims 19 and 28, respectively and which add further limitations, are believed to be in condition for allowance. Withdrawal of the rejection is respectfully requested.

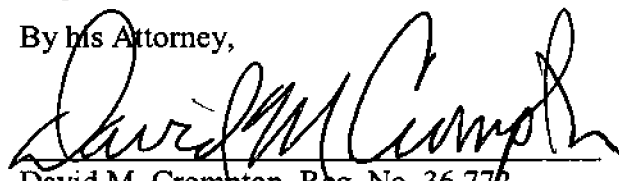
### **Conclusion**

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Roger Farnholtz

By his Attorney,



David M. Crompton, Reg. No. 36,772  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349

Date: \_\_\_\_\_

7/21/09